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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/881,678

06/18/2001

Albrecht Schneider

P06568US01/MP

7203

881

7590

03/20/2003

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EXAMINER

WILLIAMS, KEVIN D

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,678

Applicant(s)

SCHNEIDER, ALBRECHT

Examiner

Kevin D. Williams

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,13 and 18-26 is/are rejected.
- 7) ☒ Claim(s) 14-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 26 is objected to because of the following informalities:

The "support table" recited in claim 26 lacks antecedent basis since the support table of claim 12 is recited in the alternative and is not necessarily a positive part of the invention. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 12 recites "the workpiece disposed between the marking tool and the counter support." Claim 26 recites "the counter support can be fixed in place on the punch holder or the support table." It is unclear how the counter-support can be fixed on the punch holder or the support table **and** the workpiece disposed between the marking tool and the counter support. The specification does not describe this feature in a manner that would enable one skilled in the art to make and/or use the invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12, 20, 21, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirate (US 5,775,215).

Hirate teaches an apparatus for marking a sheet-shaped workpiece comprising at least one marking tool 23 and at least one counter-support 25 located opposite the marking tool, the apparatus being configurable with the workpiece disposed between the marking tool and the counter support, the marking tool having a tool tip which can be pressed onto or into a marking surface of the workpiece against a restoring force of an elastic element, the marking tool being fixed in place on a punch holder 3 or a holder of a workpiece support table of a punch press, where the counter-support 25 can be fixed in place relative to the workpiece and disposed on a side of the workpiece opposite the marking surface, an adjustable support 3 associated with the marking tool by means of which the tip and/or the prestress of its restoring spring can be adjusted, the tip capable of penetrating the surface of the workpiece to a predetermined depth to inscribe a mark, the counter-support 25 being aligned with the marking tool 23 and can be fixed in place on the punch holder or the support table 5.

5. Claims 12, 13, 20 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Andou (US 5,474,319).

Andou teaches an apparatus for marking a sheet-shaped workpiece comprising at least one marking tool 15 and at least one counter-support 21 on the side of the workpiece located opposite the marking tool, the counter-support including at least one rotatable support roller 21 or support ball for the movable support of the workpiece, the marking tool having a tool tip which can be pressed onto or into the workpiece against a restoring force of an elastic element 7, the marking tool being fixed in place on a punch holder 38 or the holder at the workpiece support table of a punch press, where the counter-support can be fixed in place on the other side of the workpiece, an adjustable support 45 associated with the marking tool by means of which the position of the tool tip and/or the prestress of its restoring spring can be adjusted, the counter-support 21 being aligned with the marking tool 15.

6. Claims 12, 20, 22, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Rohr (US 5,188,047).

Rohr teaches an apparatus for marking a sheet-shaped workpiece comprising at least one marking tool 78 and at least one counter-support 69 located opposite the marking tool, the apparatus being configurable with the workpiece 10 disposed between the marking tool and the counter support, the marking tool having a tool tip which can be pressed onto or into a marking surface of the workpiece against a restoring force of an elastic element 76, the marking tool being fixed in place on a punch holder 77 or a holder of a workpiece support table of a punch press, where the counter-support 69 can be fixed in place relative to the workpiece and disposed on a side of the workpiece opposite the marking surface, an adjustable support 77 associated with the marking tool

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by means of which the tip and/or the prestress of its restoring spring can be adjusted, the marking tool 78 comprising an ink point comprising a ball point, a roller ball point, a felt tip, or a grease pencil, the counter-support 69 being aligned with the marking tool 78.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirate in view of Canning (US 5,393,707).

Hirate teaches the claimed invention but does not mention the shape of the tool tip or from what material the tool tip is made.

Canning teaches a marking apparatus comprising a diamond tool tip 15 of conical shape.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hirate to have the diamond tip as taught by Canning because of the extreme durability of diamond.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andou in view of Sawa (US 5,344,243).

Andou teaches the claimed invention except for the tool tip being selected from the group consisting of diamond, boron nitride, or a hard alloy.

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Sawa teaches a marking apparatus comprising a tool tip being selected from the group consisting of diamond, boron nitride, or a hard alloy (Abs.). Sawa teaches the advantage of printing at high speeds with a tool tip made from a hard alloy.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Andou to have the tool tip as taught by Sawa in order to produce quality prints at high speeds.

10. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirate in view of Rohr (US 5,188,047).

Hirate teaches the claimed invention except for the tool tip comprising a ball point, a roller point, a felt tip, or a grease pencil.

Rohr teaches a marking apparatus comprising a tool tip comprising a ball point, a roller point, a felt tip, or a grease pencil (78).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hirate to have the writing utensil as taught by Rohr, in order to mark workpieces with identifying indicia that does not damage the surfaces of the workpieces.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirate in view of Keller (US 6,164,203).

Hirate teaches the claimed invention except for the marking tool comprising plastic or brass.

Keller teaches a marking apparatus comprising plastic or brass (col. 12, line 44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hirate to have the marking apparatus comprise plastic as taught by Keller, in order to utilize an inexpensive yet durable material.

Response to Arguments

12. Applicant's arguments, see paper No. 9, filed 1/13/2003, with respect to the rejection(s) of claim(s) 12, 20, and 21 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hirate.

13. Applicant's arguments filed 1/13/2003 have been fully considered but some of them are not persuasive.

Applicant argues that the Andou reference is not analogous to the claimed invention and therefore Andou does not anticipate applicant's claims. Please note that nonanalogous art arguments cannot overcome a rejection under 35 U.S.C. 102(b).

Applicant's arguments with respect to claims 18 and 19 (Hirate in view of Canning) have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the Andou and Sawa references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art references are in the field of applicant's

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endeavor. Applicant's claims are drawn to an apparatus for marking a sheet-shaped workpiece. The Andoua and Sawa references are both concerned with marking on a sheet-shaped workpiece.

Applicant argues that Rohr is nonanalogous art and that one skilled in the art looking to improve the Hirate device would not be inclined to look to the Rohr reference. Hirate teaches a device for marking on sheet-shaped workpieces. Rohr also teaches a device for marking on sheet-shaped workpieces. One skilled in the art looking to mark on sheet-shaped workpieces would certainly be inclined to look to the Rohr reference for its apparent advantages.

Applicant argues that Keller is nonanalogous art and that one skilled in the art looking to improve the Hirate device would not be inclined to look to the Keller reference. Hirate teaches a device for marking on sheet-shaped workpieces. Keller also teaches a device for marking on sheet-shaped workpieces. One skilled in the art looking to mark on sheet-shaped workpieces would certainly be inclined to look to the Keller reference for its apparent advantages.

Allowable Subject Matter

14. Claims 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

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The primary reason for the indication of the allowability of claim 14 is the limitation of the marking tool including rotatable support rollers or support balls seated in an elastically spring-loaded manner for supporting the workpiece in combination with the other claimed subject matter.

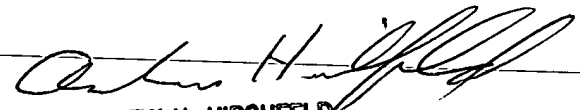
Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin D. Williams whose telephone number is (703) 305-3036. The examiner can normally be reached on Monday - Friday, 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

KDW
March 18, 2003



ANDREW H. HIRSHFELD
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